

**THIS DECISION IS NOT
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OF THE TTAB**

Mailed:
August 4, 2006
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Golden West Financial

Serial No. 78398981

Seth I. Appel of Harvey Siskind LLP for Golden West Financial.

Hanno Rittner, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Bucher, Kuhlke and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On April 4, 2004, Golden West Financial (applicant) applied to register the mark PICK-A-PAYMENT in standard-character form on the Principal Register for services identified as "savings and loan services" in International Class 36. Applicant alleges both first use anywhere and first use of the mark in commerce on December 19, 2002.

The Examining Attorney has refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), on the ground that PICK-A-PAYMENT is merely descriptive of

"savings and loan services." Applicant has appealed. Both applicant and the examining attorney have filed briefs. Applicant did not request an oral hearing. For the reasons indicated below, we reverse.

A term is merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978).

To determine whether a term is merely descriptive we must consider the term not in the abstract, but in relation to the services for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the services because of the manner of its use. In re Polo International Inc., 51 USPQ2d 1061 (TTAB 1999); and In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). It is settled that:

... the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or

services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. See, e.g., In re Tower Tech, Inc., 64 USPQ2d 1314 (TTAB 2002)(SMARTTOWER merely descriptive of commercial and industrial cooling towers); In re Putnam Publishing Co., 39 USPQ2d 2021 (TTAB 1996)(FOOD & BEVERAGE ONLINE merely descriptive of news information services for the food processing industry).

In this case the examining attorney argues that the mark is merely descriptive by stating: "As applied to Applicant's loan program services, 'PICK-A-PAYMENT,' taken as a whole, immediately and unambiguously refers to a feature of such loan program. That is, prospective customers will require no imagination, thought or

perception to determine that applicant's loan services will allow the borrower to select the type of mortgage payment." In support of this argument the examining attorney cites applicant's description of the relevant loan program on its website where applicant indicates that, "Every month you decide which payment amount you would like to make: 1. Negative Amortization Payments 2. Interest Only Payments 3. Interest and Principal Payments." And later the description indicates further: "Pick A Payment offers four tremendous choices: Minimum Payment - Interest Only Payment - Fully Indexed 30 Year Payment - 15 Year Payment."

The examining attorney also refers to applicant's website to establish that "savings and loan services" include lending services, and specifically various types of home loans. Applicant does not dispute this fact, nor the fact that its mark is applied to the specific type of home loan described on its site.

The examining attorney also provides dictionary definitions of "pick" - "to select" - and "payment" - "an amount paid" to establish that the mark is merely descriptive.

During the prosecution of the application, the examining attorney had also relied on 11 excerpts from websites showing uses of PICK-A-PAYMENT. In a request for

reconsideration applicant addressed this evidence.

Applicant indicated that all but two of the examples were either its own use, uses by brokers referring to its program, or other third-party references to its program. Applicant indicates further that it "policed" these uses. That is, applicant required that the operators of the sites either correct the references to the mark, for example, by using the "TM" symbol, or discontinue use. See unnumbered pages 2 and 3 in applicant's Request for Reconsideration.

The two remaining examples, which applicant apparently was unable to explain or police, are ambiguous. Example 2 from the examining attorney's evidence is a short, truncated excerpt from a web page at loanshoppers.net which appears to explain various types of loans. It lists "Pick A Payment - 4 payment options" but it is unclear whether this refers specifically to applicant's program. Example 4 from the examining attorney's evidence is another short, truncated excerpt from a web page at sabox.com which shows "pick a payment" four times in headings and text, always underlined or in bold. For example, at one point the text states, "Good and bad credit welcome... **pick a payment mortgage** loan personal small unsecured... Fill out one simple form and receive up to four purchase **mortgage** or refinance **mortgage** loan offers within hours." The nature of these

uses is also unclear. See attachments to the examining attorney's final action.

The examining attorney does not discuss the specifics of this evidence in his brief but instead emphasizes, "The fact that an applicant may be the first and sole user of a merely descriptive or generic designation does not justify registration where the evidence shows that the term is merely descriptive of the identified goods and/or services (citations omitted)."¹

Applicant argues that, "Applicant's description of its PICK-A-PAYMENT program on its website demonstrates how non-descriptive the proposed mark is. If the proposed mark were merely descriptive, rather than suggestive, this description would be unnecessary." In its reply brief applicant argues that, "its proposed mark has no clear significance without the use of imagination, thought, and perception." Applicant also argues that the alliteration in the mark contributes to its distinctive character. Based on these and other arguments applicant urges that we find its mark suggestive.

¹ In responding to the Request for Reconsideration the examining attorney did not offer any new Internet or similar evidence in support of his position.

After considering all evidence of record, we find applicant's position persuasive. The phrase PICK-A-PAYMENT itself appears to be suggestive rather than merely descriptive of the services, whether one looks to the broad identification in the application "savings and loan services" or to the more specific description of the service applicant provides on its website. The dictionary meanings alone are not sufficient to establish that the mark is merely descriptive of the services. PICK-A-PAYMENT is more than the sum of its parts.

The mark suggests that the borrower is in control; more importantly, it also suggests simplicity. The suggestion in the mark that a borrower simply "selects" a payment or "amount" it wishes to pay is, to say the least, an oversimplification. In fact, the "choice" involves a combination of complex contract provisions related to the term of the loan, the interest rate, and whether or not any principal is included in a particular payment. Terms which are not only complex but consequential. Thus the mark suggests, contrary to reality, that the borrower is in control and simply chooses how much it will pay in a given month; it does not merely describe the services. Some thought and perception are required to determine the true significance of the mark in relation to the services. See

In re Reynolds Metals Co., 480 F.2d 902, 178 USPQ 296 (CCPA 1973); In re Geo. A. Hormel & Co., 218 USPQ 286 (TTAB 1983).

Also, while the alliteration in the mark may not be sufficient by itself to find the mark distinctive, it does contribute to its distinctive character. Cf. Safe-T Pacific Co. v. Nabisco, Inc., 204 USPQ 307 (TTAB 1979); In re Joseph Bancroft & Sons Co., 129 USPQ 329 (TTAB 1961).

Finally, the evidence of record, most importantly the Internet evidence, is insufficient, as it stands, to establish that PICK-A-PAYMENT has come to be used and understood by relevant consumers in a merely descriptive sense. In re Remacle, 66 USPQ2d 1222 (TTAB 2002). In our assessment of this evidence we have taken into account applicant's explanations and actions with regard to that evidence.

We acknowledge that we are not without doubt in reaching this conclusion, but we must resolve any doubt on behalf of applicant. See In re Aid Laboratories, Inc., 221 USPQ 1215 (TTAB 1983); In re Conductive Systems, Inc., 220 USPQ 84 (TTAB 1983).

Accordingly, we conclude on this record that PICK-A-PAYMENT is not merely descriptive for "savings and loan services."

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Decision: The refusal to register under Trademark Act
Section 2(e)(1) is reversed.